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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/777,884
Filing Date: February 07, 2001
Appellant(s): JOHANSON ET AL.

John E. Curtin, Reg. No. 37,602
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/29/2010 appealing from the Office action mailed 6/1/2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 3, 5, 19, 30-35, and 37 are rejected and remain pending.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner.

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

US 5907293	Tognazzini	5/25/1999
US 6204844	Fumarolo et al.	3/20/2001
US 6246376	Bork et al.	6/12/2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

I. CLAIM REJECTIONS - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

A. Claims 19 and 32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time

the application was filed, had possession of the claimed invention. The limitation is a negative limitation (i.e., "selecting a device from among nearby devices that are not grouped") that is contradicted by Applicant's specification.

It is important to note that the limitation "that are not grouped" is neither described or defined in Applicant's specification. The limitation is therefore given its broadest reasonable interpretation consistent with Applicant's specification.

Contrary to Applicant's argument, Applicant's specification seems to suggest "grouping" all nearby devices [Applicant's printed publication 20030018744, 0015]. Specifically, the specification states that a first device "communicates with all nearby electronic devices to obtain the GPS location of each [nearby] device." The first device "then displays where each other electronic device is in relation" to the first device.

Displaying all nearby devices is in effect "grouping" all nearby devices. Moreover, claim 3 states displaying only those devices "within a certain range." This limitation essentially requires "grouping" all nearby devices that are "within a certain range." For the foregoing reasons, Applicant's arguments are not persuasive. The examiner maintains that the limitation is not supported (and in fact contradicted) by the specification.

The issue is that Applicant is attempting to overcome the prior art by using claim terminology from the cited references rather than Applicant's own specification. Applicant's attempt to distinguish the instant invention over the cited references would prove more fruitful if the claim terms were actually described in or defined by Applicant's own specification.

II. CLAIM REJECTIONS - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

A. Claims 3, 5, 19, 30-35, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fumarolo et al., U.S. Patent Number 6,204,844 [“Fumarolo”], in view of Bork et al., U.S. Patent Number 6,246,376 [“Bork”], in further view Tognazzini, U.S. Patent No. 5,906,293.

Some claims will be discussed together. Those claims which are essentially the same are rejected under the same rationale applied to the described claim.

Claims 19 and 32

Fumarolo as modified by Bork and Tognazzini discloses a method for selecting a nearby device, from among a plurality of nearby devices that are not grouped [Fumarolo, column 3 «lines 29-36»: selecting a device based on its location on a map and then grouping the devices based after the device has been selected] to communicate with, comprising the steps of:

transmitting a Bluetooth signal (Bork, column 4, lines 60-64 and column 5, lines 13-17);

detecting a plurality of Bluetooth signals from the nearby devices that are not grouped, each signal containing GPS coordinates of at least one nearby device (Bork, column 4, line 64 through column 5, line 2, for the use of Bluetooth, and Fumarolo, column 5, lines 35-41 and column 13, lines 32-42) and a device type of the at least one nearby device [Tognazzini, Fig. 7 «item 760» | column 7 «lines 47-65»]; and

selecting one of the nearby devices that are not grouped associated with one of the detected signals to communicate with based on the received GPS coordinates (Fumarolo, column 5, line 61 through column 6, line 12 and column 13, lines 32-42).

As indicated in the foregoing mapping, Fumarolo did not explicitly state (1) that his system's devices could communicate using Bluetooth signals or (2) sending a signal containing a device type of at least one nearby device. However, such a feature was well known in the art at the time of Applicant's invention as evidenced by Bork and Tognazzini.

1. Bork discloses transferring a signal containing GPS coordinates of a nearby device using Bluetooth.

Fumarolo's system does utilize a wireless infrastructure and it could easily be adapted to operate using any type of known wireless network. Furthermore, the ability to transfer GPS coordinates between devices using Bluetooth was well known in the art at the time of the applicant's invention as evidenced by Bork.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system of Fumarolo by adding the ability to transmit and detect Bluetooth signals in such a communications system as provided by Bork. Here the combination satisfies the need for a GPS device that can communicate its location with another trusted device by using Bluetooth or a cellular link. See Bork, column 3, lines 29-34. This rationale also applies to those dependent claims utilizing the same combination.

2. Tognazzini discloses transferring a signal containing a device type of a nearby device.

Like Fumarolo, Tognazzini is directed to a system for detecting and selecting a nearby device from among a plurality of devices [Tognazzini, abstract]. Also like Fumarolo, Tognazzini

discloses transferring signals to nearby devices that contain information in order to enable the detection of the location of the nearby device [Fig. 7: "GPS Coordinates"].

Tognazzini further discloses detecting a device type of the nearby device [Fig. 7 «item 760»: car type | Fig. 8 «items 840, 845, 855, 865»: detecting the source of the packet where the device types include different vehicles, proximity radar, stationary radar]. It would have been obvious to one of ordinary skill in the art to have modified Fumarolo to include the device type as taught in Tognazzini.

Such a modification would have improved Fumarolo's system by enabling specific icons to be displayed on the map that correspond to the different vehicle types [Tognazzini, column 3 «lines 35-38»: different icons based on source of packet].

Claims 30 and 33

Fumarolo as modified by Bork and Tognazzini discloses the method as in claim 19 further comprising the step of: displaying the location of each nearby device associated with received GPS coordinates (Fumarolo, column 5, lines 35-41); and selecting the nearby device to communicate with based on the displayed locations (Fumarolo, column 13, lines 43-58).

Claims 31 and 34

Fumarolo as modified by Bork Tognazzini discloses the method as in claim 30 further comprising selecting a nearby device associated with a shortest location (Fumarolo, column 16, lines 8-26 and column 17, lines 25-42).

Claims 3 and 35

Fumarolo as modified by Bork and Tognazzini discloses the method as in claim 30 further comprising displaying only those nearby devices within a certain range (Fumarolo, column 16, line 54 through column 17, line 6).

Claims 5 and 37

Fumarolo as modified by Bork and Tognazzini discloses the method as in claim 4 further comprising the step of displaying the type of nearby device associated with each detected signal [Tognazzini, column 8 «lines 4-24»: determining the source (i.e., device type) of the packet (e.g., vehicle, stationary radar, proximity radar) and then changing the icon based on the source of the packet. The different icons represent the "device type" of the source].

See rejection of claims 19 and 32 for reasons to combine Fumarolo and Tognazzini.

(10) Response to Argument

I. THE § 112, FIRST PARAGRAPH REJECTION OF CLAIMS 19 AND 32 SHOULD BE MAINTAINED BECAUSE APPELLANT’S SPECIFICATION DOES NOT SUPPORT AND INSTEAD CONTRADICTS THE CLAIMED LIMITATION.

Claims 19 and 32 stand rejected under 35 U.S.C. § 112, first paragraph for failing to comply failing to comply with the written description requirement. Specifically, the limitation requiring “selecting a nearby device, from among a plurality of nearby devices that are not grouped” is a negative limitation that does not have proper basis in the original disclosure. MPEP § 2173.05(i). Moreover, “[t]he mere absence of a positive recitation is not basis for an exclusion.” MPEP § 2173.05(i).

Appellant's specification provides no clear description that the devices cannot or must not be grouped prior to the selection of a nearby device. Appellant is simply relying on the fact that the specification is silent as to whether the devices should be grouped. However, as stated in the foregoing MPEP section, mere absence of a recitation of subject matter is not a basis for excluding the subject matter from the claim.

Additionally, Appellant's specification contradicts the claim language by requiring devices to be grouped based on proximity prior to selecting a device. Citing page 6, line 11 to page 7, line 3, Appellant argues that the specification describes a nearby device that is selected by a user is "individually selected from nearby devices that have not been grouped either before or during the selection" (emphasis added). Appeal Brief, pgs. 4-5. Appellant notes that that the user selects a device from "all nearby devices" but asserts that "all nearby devices" is not a kind of "grouping."

Appellant's specification states that a "device communicates with all nearby electronic devices." Spec., pg. 4, ll. 14-16. In determining which devices are "nearby", the maximum range between devices may be defined by the Bluetooth protocol. Spec., pg. 9, ll. 3-6. Appellant's invention therefore requires grouping devices by proximity (i.e., within a certain range) and then allowing a user to only select those devices within that range.

Appellant however argues that "[a]s consistently used throughout the present file history, 'grouping' or 'grouped'...means...forming a subset or subgroup of nearby electronic devices before communicating with such devices." App. Br., pg. 5, ¶5. In other words, Appellant argues that the "are not grouped" phrase should be interpreted to mean a subset of the nearby devices. This argument finds no support from Appellant's specification and simply represents an attempt

to overcome a reference by using language from the reference rather than language that finds clear support in Appellant's own specification.

To sum, Appellant's specification is silent as to whether devices may or may not be grouped prior to selection but silence as to specific subject matter does not constitute support for a negative limitation. Moreover, Appellant's specification clearly requires "grouping" based on distance prior to selection and therefore fails to provide clear support for the limitation.

II. THE § 103 REJECTIONS OF CLAIMS 3, 5, 19, AND 30-37 SHOULD BE MAINTAINED BECAUSE THE CITED REFERENCES TEACH ALL OF THE FEATURES AS CLAIMED.

A. Fumarolo and Tognazzini disclose the limitations as claimed.

Appellant argues that Fumarolo and Tognazzini do not disclose the limitations of (1) detecting a plurality of Bluetooth signals from nearby devices that are not grouped, each signal containing GPS coordinates of at least one nearby device and a device type of the at least one nearby device; and (2) selecting one of the nearby devices that are not grouped associated with one of the detected signals to communicate with based on the received GPS coordinates.

Appellant's arguments should not be found persuasive for the following reasons.

With respect to the first limitation, Appellant argues that Fumarolo requires grouping the devices according to GPS coordinates prior to selection of a device. However, Fumarolo clearly discloses that a user selects a communication unit from a displayed map wherein the map includes locations of communications units and that this selection occurs before the communication unit is placed into a talkgroup. Col. 3, ll. 27-36 and Fig. 6, items 605, 613.

Appellant acknowledges this teaching but argues that "the selection [of the communication unit]...relates to the formation of talkgroups, not the selection of a nearby device that has not been grouped associated with a detected signal." App. Br., pg. 8, ¶6. While

Fumarolo discloses later placing the selected communication devices into a talkgroup, Appellant's claim does not prohibit placing the devices into a group after they have been selected. The claims merely state that the devices are not grouped before the devices are selected.

Consistent with Appellant's claim language, Fumarolo first discloses a user terminal detecting signals from nearby devices in order to place the nearby devices on a map for display on the user terminal. That is, the devices' respective locations on the displayed map is based on the detected location signal so a selection of the device based on the map location is necessarily associated with the detected location signal. Fumarolo then discloses that a user may select a device from the map based on the displayed location. These teachings are consistent with Appellant's claims 19 and 32.

With respect to the second limitation, Appellant argues that Tognazzini does not disclose a signal comprising a device type of the at least one nearby device. Appellant argues that the claimed device type "means a type of communication device" while Tognazzini discloses a device type that represents a type of car. Appellant's argument should not be found persuasive because Fumarolo and Tognazzini's disclosure of a vehicle reads on Appellant's broadly claimed "device."

Fumarolo discloses detecting nearby vehicles using wireless methods. Fumarolo, Fig. 1, items 105-110 and column 4, ll. 25-27. Similarly, Tognazzini discloses an invention for detecting nearby vehicles. Tognazzini, abstract. Tognazzini discloses that the vehicles can communicate with each other using a variety of wireless methods including GPS, proximity radar, or radio/radio-telephone. Tognazzini, Fig. 1, items 110, 115, 120 and column 3, ll. 4-7. \

Tognazzini further discloses including the make/model (i.e., type) of the vehicle in the signal "in order to provide enhanced information on the receiving vehicle's color display."

Tognazzini, col. 3, ll. 11-15 and col. 7, ll. 63-65. The vehicle's make/model therefore impacts how the vehicle is displayed on the map. The proposed combination simply modifies Fumarolo's location signal to include a vehicle type in order to provide enhanced information on the user's map.

B. The combination of Fumarolo, Bork, and Tognazzini is proper.

Appellant argues that one of ordinary skill in the art would not have modified Fumarolo to include Bluetooth signals as taught in Bork because Bluetooth would "most likely not have the distance or range needed to carry out the principle of operation of Fumarolo or Tognazzini." App. Br., pg. 10, ¶1.

This argument was previously addressed in the Board decision dated August 24, 2009. In that decision, the Board explicitly found the combination of Fumarolo and Bork to be proper as a combination of familiar elements and a predictable use of prior art elements according to their established functions. See Decision, pg. 7, ¶¶3-4.

Appellant further argues that combining Bork and Tognazzini would require "Tognazzini to impermissible[sic] change its principle of operation." This argument should not be found persuasive since Fumarolo is the primary reference being modified to include the features taught by Bork (i.e., the Bluetooth functionality) and Tognazzini (i.e., including device type in a signal to another device). Therefore, Appellant's focus on Tognazzini is misplaced.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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